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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/186,962 11/05/98 RHOADS

G 4830-50848/W

EXAMINER

LM31/1112

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DIGIMARC CORPORATION
ONE CENTERPOINTE DRIVE
SUITE 500
LAKE OSWEGO OR 97035-8615

COUSD, J

ART UNIT

PAPER NUMBER

2721

DATE MAILED:

11/12/99

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/186,962

Applicant(s)

KH0A35

Examiner

J.L. GUSO

Group Art Unit

2721

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 11/5/98
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 2 - 18 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2 - 18 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 2-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Powell et al. ('788) in view of Shear.

Powell et al. ('788) disclose a method and system for digital image signatures.

With regard to claim 2, Powell et al. ('788) provide for obtaining audio or image files by downloading from plural computer sites (refer for example to column 1, lines 12-21 and column 2, line 60 through column 3, line 17); identifying plural of the obtained files having certain digital watermark data embedded therein, and decoding the digital watermark data therefrom (refer for example to column 5, line 49 through column 6, line 43); by reference to the decoded digital watermark data, determining proprietors of each of the plural files (refer for example to column 6, line 44 through column 7, line 14); and sending information relating of the foregoing monitoring to the determined proprietors (refer for example to column 1, lines 12-49 and column 5, lines 44-54); wherein the proprietors of audio or image files are alerted to otherwise unknown distribution of their audio or image properties on computer sites (refer for example to column 1, lines 12-49 and column 5, lines 44-54).

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Although Powell et al. ('788) do not specifically state that the system is obtaining audio or image files from plural different Internet sites, the obtaining of audio or image files from plural different Internet sites is well known and widely utilized in the prior art.

Shear discloses a data base usage metering and protection system and method which specifically discusses the obtaining audio or image files from plural different Internet sites (refer for example to column 1, lines 33-49).

Given the teachings of the two references and the same environment of operation one of ordinary skill in the art at the time the invention was made would have been led in an obvious fashion to provide for obtaining audio or image files from plural different Internet sites as taught by Shear in the Powell et al. ('788) system since both systems are primarily concerned with the usage of and protection of digital data. This is a routine design choice which fails to patentably distinguish over the prior art absent some novel and unexpected result.

In regard to claim 3, Powell et al. ('788) provide for decoding the digital watermark data with reference to public key data (refer for example to column 6, lines 18-43).

With regard to claim 4, Powell et al. ('788) provide for decoding the digital watermark data with reference to private key data (refer for example to column 6, lines 18-43).

As to claim 5, Powell et al. ('788) provide for identifying by including performing a domain transformation on data from at least certain of the files, yielding transformed data (refer for example to column 5, lines 29-36).

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In regard to claim 6, Powell et al. ('788) provide for identifying by including performing a matched filtering operation on the transformed data (refer for example to column 6, lines 44-53).

With regard to claim 7, Powell et al. ('788) provide for a domain transformation (refer for example to column 5, lines 29-36). Although the domain transformation is not a 2D FFT transform, to use this particular type of transform would have been obvious to one of ordinary skill in the art at the time the invention was made given the teachings of the Powell et al. ('788) reference.

As to claim 8, Powell et al. ('788) provide for a domain transform (refer for example to column 5, lines 29-36). Although the domain transformation is not a one-dimensional transform, to use this particular type of transform would have been obvious to one of ordinary skill in the art at the time the invention was made given the teachings of the Powell et al. ('788) reference.

In regard to claim 9, Powell et al. ('788) provide for the identifying further includes generating column integrated scan data for at least one oblique scan through an obtained image, and performing a transformation thereon (refer for example to column 5, lines 29-36). Although the domain transformation is not a one-dimensional FFT transform, to use this particular type of transform would have been obvious to one of ordinary skill in the art at the time the invention was made given the teachings of the Powell et al. ('788) reference.

With regard to claim 10, Powell et al. ('788) provide for the identifying includes transformation (refer for example to column 5, lines 29-36). Although the domain transformation is not one which computes power spectrum data, to use this particular type of transform would

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have been obvious to one of ordinary skill in the art at the time the invention was made given the teachings of the Powell et al. ('788).

As to claim 11, Powell et al. ('788) provide for low-pass filtering (refer for example to column 5, lines 29-36).

In regard to claim 12, Powell et al. ('788) provide for analyzing a spectral characteristic of at least certain of the obtained files to identify the possible presence of digital watermark therein (refer for example to column 6, lines 18-43).

In regard to claim 13, Powell et al. ('788) provide for screening the obtained files to identify a subset thereof, and undertaking the decoding operation only for files in the subset ().

With regard to claim 14, Powell et al. ('788) provide for the screening includes detecting a pattern in the file ().

As to claim 15, Powell et al. ('788) provide for the decoding includes performing at least one statistical analysis. (refer for example to column 6, lines 18-43).

In regard to claim 16, Shear provides for obtaining includes automatic computer downloading of image or audio files, without specific human instruction of particular files to be downloaded (refer for example to column 1, lines 33-49).

With regard to claim 17, Powell et al. ('788) provide for the decoded watermark data provides a reference to a registry database, and the method further includes obtaining additional data from the registry database by use of the reference, the additional data identifying the

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proprietor of the file from which the watermark data was decoded (refer for example to column 1, lines 12-14 and column 5, lines 44-54).

As to claim 18, Powell et al. ('788) provide for generating reports relating to results of the monitoring, and sending the reports to the determined proprietors (refer for example to column 1, lines 12-14 and column 5, lines 44-54).

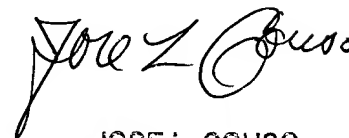
3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rhoads discloses methods for surveying dissemination of proprietary empirical data.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jose L. Couso whose telephone number is (703) 305-4774. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached on (703) 305-4706. The fax phone number for this Group is (703) 308-9051 or (703) 306-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-8576.



JOSE L. COUSO
PRIMARY EXAMINER

jlc
October 13, 1999